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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,409	10/03/2001	Matthew Shulman	213792	2545

7590 05/03/2006
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EXAMINER

INGBERG, TODD D

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,409

Applicant(s)

SHULMAN ET AL.

Examiner

Todd Ingberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 23-25, 27, 28, 30, 32, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) 22, 26, 31 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 – 20 have been cancelled.

Claims 21 – 35 have been examined.

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101. **Basis of this rejection is under *In re Goodman* (CA FC) 29 USPQ2d 2010 (December 3, 1993).**

2. Claims 21, 23, 24, 25, 27, 28, 30, 32, 34 and 35 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 5, 10, 20, 26, 27 and 29 of prior U.S. Patent No. 6,311,323. This is a double patenting rejection.

Claim 21 of the Instant Application is anticipated by patent claim 1 in that claim 1 of the patent contains all the limitations of claim 21 of the instant application. Claim 21 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 23 of the Instant Application is anticipated by patent claim 1 in that claim 1 of the patent contains all the limitations of claim 23 of the instant application. Claim 23 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

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Claim 24 of the Instant Application is anticipated by patent claim 1 in that claim 1 of the patent contains all the limitations of claim 24 of the instant application. Claim 24 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 25 of the Instant Application is anticipated by patent claim 1 in that claim 1 of the patent contains all the limitations of claim 25 of the instant application. Claim 25 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 27 of the Instant Application is anticipated by patent claim 29 in that claim 29 of the patent contains all the limitations of claim 27 of the instant application. Claim 27 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 28 of the Instant Application is anticipated by patent claims 26 and 27 in that claims 26 and 27 of the patent contains all the limitations of claim 28 of the instant application. Claim 28 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 30 of the Instant Application is anticipated by patent claim 29 in that claim 29 of the patent contains all the limitations of claim 30 of the instant application. Claim 30 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 32 of the Instant Application is anticipated by patent claim 1 in that claim 1 of the patent contains all the limitations of claim 32 of the instant application. Claim 32 of the instant

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application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 34 of the Instant Application is anticipated by patent claim 10 in that claim 10 of the patent contains all the limitations of claim 34 of the instant application. Claim 34 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim 35 of the Instant Application is anticipated by patent claim 5 in that claim 5 of the patent contains all the limitations of claim 35 of the instant application. Claim 35 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Allowable Subject Matter

3. Claims 22, 26, 31 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant should verify they do not introduce antecedent basis issues in the claims with any amendment.

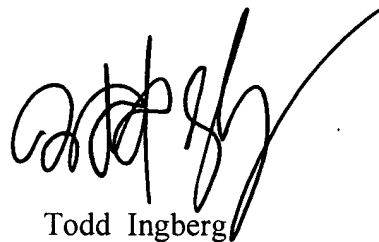
Correspondence Information

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Todd Ingberg', with a long, sweeping flourish extending from the end.

Todd Ingberg
Primary Examiner
Art Unit 2193

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